

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

Applicant: Robert D. Hill

Title: METHOD OF MODIFYING PLANT  
PHENOTYPES WITH NONSYMBIOTIC  
HEMOGLOBIN

Appl. No.: 10/582,321

Filing Date 05/22/2007  
(§371(c)):

Examiner: Phoung T. Bui

Art Unit: 1638

Confirmation 4952  
Number:

REQUEST FOR PARTICIPATION IN PPH PILOT PROGRAM  
BETWEEN THE USPTO AND THE EPO &  
PETITION TO MAKE SPECIAL UNDER PPH PILOT PROGRAM

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant hereby requests that the captioned application be permitted to participate in the Patent Prosecution Highway Pilot Program (PPH) between the USPTO and the EPO.

As of the time of filing of this Request, examination of the application has not begun.

This entire request, including the supporting documents and Preliminary Amendment to conform the claims to those granted by the EPO, is submitted by EFS-Web.

The petition fee under 37 CFR § 1.17(h) for the petition to make special under 37 CFR § 1.102(d) is submitted herewith via credit card payment form. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 19-0741, including the full payment of the petition fee if somehow not submitted herewith.

The relevant information required on PTO/SB/20EP is set forth below:

**U.S. Application No.:** **10/582,321**

U.S. Filing Date (§371(c)): May 22, 2007

First Named Inventor: Robert D. Hill

Attorney Docket No.: 049280-0102

Title of the Invention: Method of Modifying Plant Phenotypes With  
Nonsymbiotic Hemoglobin

National Stage of

PCT Application No. PCT/IB2004/004419 filed December 10, 2004

Priority Claim: U.S. Provisional 60/528,777 filed December 12, 2003

**EPO Application No.:** **04816631.8**

EP Filing Date: December 10, 2004

National Stage of

PCT Application No. PCT/IB2004/004419 filed December 10, 2004

Priority Claim: U.S. Provisional 60/528,777 filed December 12, 2003

The U.S. application is the U.S. national stage of PCT Application  
PCT/IB2004/004419.

The EPO application is the EPO national stage of the same PCT application, PCT  
Application PCT/IB2004/004419.

PCT Application PCT/IB2004/004419 claims priority to U.S. provisional application  
60/528,777. Although the PPH guidelines indicate that the PCT application should not  
include a priority claim, Applicants believe that the priority claim to a U.S. *provisional*  
application does not disqualify the application from the PPH, nor should it for the reasons set  
forth below.

The documents required for participation in the PPH are submitted herewith,  
including:

a copy of all EPO office actions relevant to patentability issued in the EPO application; and

a copy of all claims which were determined to be patentable by the EPO in the EPO application.

The Information Disclosure Statement filed in the present application on June 10, 2008, lists all of the documents cited in the EPO application along with other references, so a new Form SB-08 is submitted herewith listing only the documents cited in the EPO application, for the Examiner's convenience. Copies of the documents already have been submitted.

A Claims Correspondence Table is provided below, showing the correspondence between the claims pending in the U.S. application as amended by the Preliminary Amendment submitted herewith, and the claims granted in the EPO application:

Claims in U.S. Application	Patentable Claims in EPO Application	Explanation of correspondence
24	1	Clerical error corrected in the last paragraph
25	2	
26	3	
27	4	
28	5	
29	6	
30	7	
31	8	
32	9	

Thus, all of the claims pending in the U.S. application sufficiently correspond to the patentable/allowable claims in the EPO application to participate in the PPH.

### **Relationship Between US and EPO Applications**

As noted above, the U.S. application and EPO application are national stage applications of the same PCT application, PCT/IB2004/004419. PCT/IB2004/004419 claims priority to U.S. Provisional application (filed 12/12/2003). Although the PPH guidelines indicate that the PCT application should not include a priority claim, Applicants believe that the priority claim to a U.S. *provisional* application does not disqualify the application from the PPH, nor should it for at least the following reasons.

As set forth in 1335 OG 196 (October 21, 2008) (the “OG Notice”), the PPH was developed in accordance with the USPTO’s 21<sup>st</sup> Century Strategic Plan “to transform the USPTO into a more quality-focused, highly productive, responsive organization supporting a market-driven intellectual property system.” The PPH directly relates to “[o]ne of the specific action items of the 21 Century Strategic Plan,” which is “to share search results with other intellectual property offices.” As stated in the OG Notice, “[b]y relying on the search results obtained via partnership with other intellectual property offices, the USPTO can reduce duplication of efforts and decrease workload.” Thus, the PPH “permits each office to benefit from the work previously done by the other office, in turn helping to reduce workload and improve patent quality.”

All of these important goals would be served by accepting this application into the PPH. That is, accepting this application into the PPH would permit the USPTO to rely on the search results obtained by the EPO, reduce duplication of examination effort, decrease total workload, and improve patent quality by advancing examination of claims already determined to be patentable by the EPO. The priority claim to the U.S. provisional application does not detract from those goals or otherwise undermine the PPH.

According to the OG, “[t]he PPH was established to enable an application whose claims are determined to be allowable in the Office of first filing (OFF) to have the corresponding application filed in the Office of second filing (OSF) advanced out of turn for examination while at the same time allowing the OSF to exploit the search and examination

results of the OFF.” In the present case, the EPO should be deemed to be the OFF for at least the following reasons:

First, the U.S. provisional application should not make the U.S. the OFF for PPH purposes because a U.S. provisional application is never searched or examined.

Second, as between applications that are eligible for search and examination, the U.S. application and the EPO application have the same effective filing dates, i.e., the December 10, 2004 filing date of the PCT application. Under such circumstances, the only basis for determining which office is the OFF and which is the OSF is the office that first commences and completes the search and examination process. Here, that is the EPO, which has examined the application and issued an intent to grant before the U.S. application even has been assigned to an examiner.

For at least these reasons, therefore, Applicant urges that the captioned application be accepted into the PPH, with the EPO being deemed to be the OFF, and the USPTO deemed to be the OSF. This will allow the USPTO to exploit the search and examination results of the EPO, thereby reducing duplication of examination effort, decreasing total workload, improving patent quality, and expediting prosecution of an application whose examination already has been delayed.

Should there be any questions regarding this submission, or should any issue remain, the Patent Office is invited to contact the undersigned attorney or record at the telephone number set forth below.

Respectfully submitted,

Date November 30, 2009

By Courtenay C. Brinckerhoff

FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 295-4094  
Facsimile: (202) 672-5399

Courtenay C. Brinckerhoff  
Attorney for Applicant  
Registration No. 37,288